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PI ase substitute claim 19 with amended claim 19 bel w:

19. The O/W microemulsion composition of claim 1 wherein the one or more insect repellent is ethyl 3-(N-acetyl-N-butylamino)propionate.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

**REMARKS****Summary of Amendments to the Claims**

Claims 10 and 11 have been amended to address the examiner's 35 U.S.C. 112, second paragraph rejections.

Claim 14 has been cancelled.

The limitations of claims 6 and 15 have been incorporated in claim 1. The dependencies of claims 7, 16, 17 and 19 have been amended to depend on claim 1 and the dependency of claim 8 have been amended to depend on claim 7. Claims 5, 7-13 and 16-19 are now pending. It is believed that no new matter has been added.

At the outset, Applicants wish to address the showing required under 37 CFR § 1.116(a) regarding why the amendments above are necessary and were not presented earlier. According to MPEP 714.13 (Amendments After Final Rejection or Action, Procedure Followed - Action by Examiner), there are four grounds (cited as (A)-(D)) upon which the examiner may elect not to enter the applicants amendment. Each ground is addressed below:

(A) The claims as amended represent a narrower embodiment of the applicants originally claimed invention (applicants reserve the right to pursue broader scope of the original claims in continuing application) and as such it is believed that the amended claims are now in condition for allowance or at the very least simplifies the issues for appeal.

(B) It is believed that no new matter has been entered.

(C) The amended claims represent a narrower embodiment of the applicants invention as claimed prior to the issuance of the examiner's final rejection and as such no new issues are

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raised which require further consideration or search.

(D) The amendment does not present any additional claims.

In view of the foregoing, Applicants respectfully request that the Examiner enter and consider the amendments above.

**35 U.S.C. 103(a) rejections**

**Claims 5-18** were rejected by the examiner over Thomas et al. in view of Neumiller (U.S. Patent 5,145,604).

**Claims 18 and 19** were rejected by the examiner as being obvious over Thomas et al., *ibid.*, in view of Neumiller, *ibid.*, further in view of Stewart (U.S. Patent 6,159,452).

In addition to the arguments previously presented over the Thomas et al. and Neumiller references, the applicants hold that the claim 5 as amended above is not rendered obvious when the additional limitations with regard to the amount and specific type of emulsifier is considered.

**Closing**

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By: Howard C. Lee  
Howard C. Lee  
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HCL:vif

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **11 February 2003**

By: Vilma I. Fernandez  
Vilma I. Fernandez

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## COPY OF ALL PENDING CLAIMS SHOWING AMENDMENTS MADE

5. An oil-in-water (O/W) microemulsion composition, comprising:
- (a) at least one emulsifier (emulsifier A) present in concentrations of 0.01 – 20% by weight based on the total weight of the composition, selected from the group consisting of [emulsifiers having the following properties
    - (i) their lipophilicity is either dependent on the pH inasmuch as an increase or decrease in pH results in an increase or decrease in lipophilicity, it being unimportant which of the two possibilities of change in the lipophilicity is effected by the increase or the decrease in the pH, and/or
    - (ii) their lipophilicity is dependent on the temperature inasmuch as the lipophilicity increases with increasing temperature and their hydrophilicity increases with decreasing temperature,
  - (b) glycerol in an amount up to 5% by weight based on the total weight of the composition,] ceteareth-12, ceteareth-15, ceteareth-20, glyceryl stearate, glyceryl isostearate, stearic acid, isoceteth-20, sorbitan monoisostearate and mixtures thereof,
  - (b) [(c)] optionally, substances which are soluble or dispersible in the oil phase or the water phase, and
  - (c) [(d)] an effective amount of one or more insect repellents.
7. The O/W microemulsion composition of claim 1 [6], wherein the emulsifier A or emulsifiers A is or are present in concentrations of 0.05 - 10% by weight, based on the total weight of the composition.
8. The O/W microemulsion composition of claim 7 [6], wherein the emulsifier A or emulsifiers A is or are present in concentrations of 0.1 - 5% by weight, based on the total weight of the composition.
9. The O/W microemulsion composition of claim 5, wherein the insect repellent(s) is/are chosen from the group consisting of ethyl 3-(N-acetyl-N-butylamino)propionate, N,N-diethyloctanamide, N,N-diethyl-m-toluamide.
10. The O/W microemulsion composition of claim 5, wherein the total amount of one or more insect repellents [in the finished cosmetic or dermatological preparations] is chosen from the range 0.1 – 15.0% by weight, based on the total weight of the composition.

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11. The O/W microemulsion composition of claim 5, wherein the total amount of one or more insect repellents **[in the finished cosmetic or dermatological preparations]** is chosen from the range 0.5 – 8.0% by weight, based on the total weight of the composition.
12. The O/W microemulsion composition of claim 5, wherein the optional substances which are soluble or dispersible in the oil phase or water phase is an emulsifier which does not have the properties of emulsifier A.
13. The O/W microemulsion composition of claim 12, wherein the emulsifier which does not have the properties of emulsifier A is a W/O emulsifier.
16. The O/W microemulsion composition of claim 1 [7] wherein the at least one emulsifier (Emulsifer A) is selected from the group consisting of cetareth-12, glyceryl isostearate, sorbitan monoisostearate and mixtures thereof.
17. The O/W microemulsion composition of claim 1 [8] wherein the at least one emulsifier (Emulsifer A) is selected from the group consisting of isoceteth-20, cetareth-20 and mixtures thereof.
18. The O/W microemulsion composition of claim 1 wherein the one or more insect repellents are selected from the group consisting of ethyl 3-(N-acetyl-N-butylamino)propionate; N,N-diethyloctanamide and combinations thereof.
19. The O/W microemulsion composition of claim 1 [6] wherein the one or more insect repellent is ethyl 3-(N-acetyl-N-butylamino)propionate.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS : DÖRSCHNER et al.  
SERIAL NO. : 09/679,054  
FILED : 3 October 2000  
FOR : COSMETIC AND DERMATOLOGICAL LIGHTPROTECTION  
FORMULATIONS IN THE FORM OF O/W MACROEMULSIONS  
OR O/W MICROEMULSIONS CONTAINING INSECT  
REPELLANTS  
ART UNIT : 1616  
EXAMINER : Marina Lamm

11 February 2003

Box AF  
Hon. Commissioner of Patents  
Washington, D.C. 20231

NOTICE OF APPEAL

Applicants hereby appeal to the Board of Appeals from the Final Office Action dated 8 November 2003 of the primary Examiner finally rejecting Claims 5-19.

The period for response to the final rejection was set to expire on 15 February 2003.

Charge the appeal fee of:

☒ \$320.00  
☐ \$160.00 - Small Entity

to Deposit Account No. 14-1263.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS, McLAUGHLIN & MARCUS, P.A.

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CERTIFICATE OF FACSIMILE TRANSMITTAL

I hereby certify that this correspondence is being transmitted via facsimile to: Box AF, The Commissioner of Patents, Washington, D.C. 20231 on the date indicated below.

NORRIS, McLAUGHLIN & MARCUS, P.A.

Date: 11 February 2003

By Vilma I. Fernandez